

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 2823  
Examiner : George R. Fourson III  
Applicant : John K. Roberts  
Appln. No. : 10/674,830  
Filing Date : September 30, 2003  
Confirmation No. : 4469  
For : RADIATION EMITTER DEVICE HAVING AN INTEGRAL  
MICRO-GROOVE LENS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action mailed December 2, 2005, Applicant responds as follows.

The request for review begins on page 2 of this paper.

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### REMARKS

Claims 1-19 are pending in the present application. Reconsideration of the rejection of claims 1-7, 11-15, and 19 is respectfully requested for the following reasons.

In the final Office Action, the Examiner rejected claims 1-7, 11-15, and 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,803,579 issued to Turnbull et al.

In the response prior to the final Office Action, Applicant antedated the Turnbull et al. reference by submitting a Declaration under 37 C.F.R. §1.131 executed by the inventor, John Roberts. In the Declaration, Mr. Roberts declared he is "the inventor of all the claims of the present patent application." Mr. Roberts further declared that as of June 13, 1996, he had constructively reduced to practice the invention as defined in claims 1-19 of the present application.

In the final Office Action, the Examiner contended that Applicant's argument that the Turnbull et al. reference was not available as prior art was unpersuasive. The Examiner contended that the reference is available as prior art under 35 U.S.C. §102(e) because the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent. However, for a reference to qualify as prior art under 35 U.S.C. §102(e), the reference must both be by another, and be filed in the United States before the invention by the Applicant for patent. Because the Declaration under 37 C.F.R. §1.131 indisputably states that John Roberts had constructively reduced the invention to practice as of June 13, 1996, and because the Turnbull et al. reference was not filed **before** the June 13, 1996 invention date, the Turnbull et al. reference is not available as prior art under §102(e) and the rejection based on Turnbull et al. should be withdrawn.

In the Advisory Action, the Examiner contends that MPEP §706.02(b) states that an affidavit filed under 37 CFR §1.131 must establish invention prior to the effective date of the reference. However, this section of the MPEP does not state this. Instead, MPEP §706.02(b) actually states:

A rejection based on 35 U.S.C. §102(e) can be overcome by:

- (A) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (B) Amending the claims to patentably distinguish over the prior art;

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(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

**(D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention**, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR \* > 41.203(a) < . See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences; [Emphasis added]

For purposes of 35 U.S.C. §102(e), "prior invention" merely means a date that is sufficient to remove the reference from qualifying as prior art under §102(e). 35 U.S.C. §102(e) states:

A person shall be entitled to a patent unless:

(e) the invention was described in ... (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,  
...

Thus, Applicant is entitled to a patent unless the claimed invention was described in a patent filed *before* the invention by the Applicant. If the effective date of the reference is the same date as the date of invention, it can not be before the date of invention. Thus, regardless of any language the Examiner may find in the MPEP, such language can not overrule the statute.

Applicant respectfully submits that the 131 Declaration is sufficient to establish June 13, 1996 as a date of invention. Therefore, the Turnbull et al. patent, which was filed on June 13, 1996,

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does not qualify as a reference under 35 U.S.C. §102(e). Applicant therefore respectfully requests the withdrawal of the rejection of claims 1-7, 11-15, and 19.

Also in the Advisory Action, the Examiner cites a portion of MPEP §716.10. Particularly, the Examiner cites:

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. In re Katz, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982).

It is not clear why the Examiner cites this portion of MPEP §716.10 insofar as Applicant has not attempted to disqualify the reference based on attribution, nor has the Examiner made any rejection under 35 U.S.C. §102(f). Applicant has clearly stated on the record in the last response that the inventorship listed in both the present application and the Turnbull et al. patent is indeed correct. First, as pointed out in MPEP §2137.01, subsection I, “the party or parties executing an oath or declaration under 37 C.F.R. 1.63 are presumed to be the inventors.” Further, §706.2(g) states “the Examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor.”

Applicant respectfully submits that the inventorship of the present application and the Turnbull et al. patent are correct and that there is no basis for the Examiner to conclude otherwise. Moreover, Applicant submits that the Declaration under 37 C.F.R. §1.131 is sufficient to overcome the only grounds of rejection.

During a telephone call on March 2, 2006, the Examiner mentioned that due to the overlapping claim scope of this application and the Turnbull et al. patent, Applicant should present a statement to the effect that the two additional inventors (Robert Turnbull and Robert Knapp) did not contribute to the invention of the subject matter commonly claimed. Applicants obliged in the subsequent response and confirmed that John Roberts is the sole inventor of the claimed subject matter of this application and that both Robert Turnbull and Robert Knapp contributed to other

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subject matter disclosed and claimed in the Turnbull et al. patent. In particular, Robert Turnbull and Robert Knapp did not contribute to the idea of configuring a surface of an encapsulant to define an optical lens that either includes a plurality of concentric circular grooves or is a divergent lens.

All pending claims 1-19 are believed to define patentable subject matter, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,  
PRICE, HENEVELD, COOPER,  
DEWITT & LITTON LLP

April 3, 2006  
Date

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